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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,113	12/29/2000	Tomoko Terakado	208366US6 CONT	6754

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

EXAMINER

SAJOUS, WESNER

ART UNIT	PAPER NUMBER
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2676

DATE MAILED: 04/04/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,113

Applicant(s)

TERAKADO ET AL.

Examiner

Wesner Sajous

Art Unit

2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33,34,37-57,60-71,74-84,87-96 and 99-108 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 33,34,37-57,60-71,74-84,87-96 and 99-108 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Remarks

This communication is responsive to the amendment and response filed on January 30, 2003. In this response, claims 36, 59, 73, 86, and 98 are canceled without disclaimer and claims 33, 47-49, 53-56, 83, and 95 are amended. As a result, claims 33-34, 37-57, 60-71, 74-84, 87-96, and 99-108 are currently pending.

Response to Arguments

1. Applicant's arguments with respect to claims 33-34, 37-57, 60-71, 74-84, 87-96, and 99-108 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 33-34, 37-39, 41-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee et al. (Darbee), Pat. No. 6130726, in view of Jones, Pat. No. 5978013.

Considering claims 33-34, Darbee, at figs. 1-2, discloses a control device (10) which controls, by transmitting a control signal (*e.g., a IR or RF transmitter, see abstract*), an electric apparatus (*e.g., a consumer electronic device or a TV set, see abstract*) including an extraction unit (*e.g., a tuner/receiver which is typical in most television set*) and an electric apparatus transmitting unit (*e.g., a conventional IR transmitter of a TV set that operates in conjunction with a remote control, see col. 4, lines 20-25*), the electric apparatus transmitting unit for transmitting additional

information (e.g., *program guide or advertisement, see abstract and col. 4, lines 33-36*) extracted by the extracting unit to a receiver (34, *fig. 2*), that receives information transmitted via a transmission medium (e.g., *an antenna or satellite*), comprising:

A transmitting unit (35) ... electric apparatus; the receiver (34) for receiving additional information (e.g., *advertising or program guide, col. 4, lines 33-36*) transmitted by the electric apparatus (e.g., *the TV set*); an output means (e.g., *items 18, or 20 or 22 or 24 or 25 of fig. 6 and/or fig. 2, items 38 and 28*) for outputting the additional information received by the receiver to a display device (14); a memory (e.g., *item 36 or 40*) for storing at least a portion of said additional information (e.g., *detail information about the current program on the channel {cols. 9-10, lines 65-2}, or detail view information about a movie {col. 14, lines 51-61}*); wherein the additional information include advertisement information (*see col. 4, lines 33-36, and col. 13, lines 5-13*) included in the information received by the electric apparatus.

It is noted that Darbee fails to show the erasing unit for deleting the information stored in the memory, and that the addition information includes coupon information.

However, Jones, in the same field of endeavor, teaches additional information includes coupon information (*see col. 4, lines 60 to col. 5, line 8*), and the erasing unit (98) for deleting the information stored in the memory (*see col. 10, lines 7-30*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the control device (10) of Darbee to include the coupon information and the erasing unit as taught by Jones. Such modification would enable a system to distribute product coupons to consumers' sites using signals transmitted via television channels, while safeguarding against fraud and misredemption and while encouraging the consumers to watch the television advertisements for the products. See Jones col. 2, lines 33-38.

In **claim 37**, the claimed "advertisement information includes URL information" is met in Darbee's col. 8, lines 5-10.

As per **claim 38**, the claimed "selecting unit for selecting information...wherein the memory is configured to store the information selected by the selection unit" is met by the functions performed by item 28 of fig. 2 in Darbee's.

Regarding **claim 39**, it is noted that all the elements recited in claim 39, including the second storing unit the second selecting unit, the second transmitting unit are noted to be components included in the consumer electronic device or the television set of Darbee, which communicates information from and to the remote controller 10, for these components are conventional elements included in a television system.

As per **claim 41**, the claimed "second electric apparatus is a personal computer, ...accesses a server based on information transmitted from the control device" would have been obvious over Darbee's col. 4, lines 50-56, since the system can access the Internet via a modem (see col. 4, lines 30-33).

In **claims 42 and 44**, the claimed "notifying unit for notifying a user of reception... transmitted in response to an instruction that was issued from the control device" is met by item 14 of fig. 1.

Re **claim 43**, the claimed "control device instructs the electric apparatus to transmit the additional information" is characterized by the function of item 28 of fig. 2.

As per **claims 45 and 46**, the claimed "output means outputs that part of the additional information which relates to a current channel reception of the electric apparatus ... from a present time onward" would have obvious the system of Darbee,

since it enables the user to view program guide, identifying PPV information (see fig. 12) select information pertaining to specific genres or categories (see fig. 32) and to retrieve the selected category (see *col. 6, lines 38-41*) transmitted from the television set. See *col. 2, lines 2, lines 6-67, col. 3, line 31 to col. 4, line 5, and col. 9, lines 58-65.*

Claim 47 recites features equivalent to claim 33; it is, therefore, rejected for the same reasons and rationale set forth for claim 33.

Claim 48 is a computer program substantially performing the same method as claim 33; it is, therefore, rejected by the same rationale as claim 33.

The invention of **claim 49**, although slightly different, it recites features capable of performing the same function as claim 33. As the various features of claim 33 have been shown to be obvious over the combined teaching of Darbee and Jones, it is readily apparent that the apparatus disclosed by the prior art performs the recited underlying functions, because in Darbee, the remote controller 10 communicates bi-directionally with a television system to transmit signals to and from the other. Hence the television set incorporates the second receiving unit, and it is able to perform operation in accordance with the control signal from the remote controller (10). Therefore, the limitations recited in claim 49 are rejected under the same rationale as claim 33.

Re **claims 50-51**, the claimed "electric apparatus is a personal computer; a television receiver" is obviously met by *col. 4, lines 50-56, and col. 4, lines 30-33.*

The invention of **claim 53**, although slightly different, it recites features equivalent to claim 49. As such, the limitations of claim 53 are rejected for the same reasons and rationale as claim 49, and incorporated herein.

The invention of **claim 54**, although slightly different, it recites performing functions equivalent to claim 53 and is similarly rejected.

The invention of **claim 55**, although slightly different, it recites performing functions equivalent to claim 48 and is similarly rejected.

3. **Claims 56-57, 60-71, 74-84, 87-96, 99-108** are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee in view of Jones and further in view of Kishtaka (6084643).

As per **claims 56-57, 61**, the combination of Darbee and Jones discloses most claimed features of the invention, as applied above for claims 33-34, however, Darbee and Jones fail to particularly suggest an IC card as a detachable storing means.

However, Takahashi, in the same field of endeavor, discloses a system including means for selecting information from the additional information received by the receiving means (fig. 3, item 6); and a detachable storing means for storing the information selected by the selection unit, --wherein the detachable storing means is an IC card (as characterized by the function of item 41 of fig. 8). It must be understood that storing means 41 could be apart from the receiver, (as is well known in the art) and could be provided to interface with the remote key for storing the user's favorite EPG or program advertisement or all other information communicated to the receiver. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have been motivated to incorporate the features of Darbee and Jones together

with Takahashi, wherein an IC card as a detachable storing means is provided, in order to limit the amount of time taken to retrieve program information stored by the user (col. 2, lines 5-15).

In **claim 60**, the claimed "advertisement information includes URL information" is met in Darbee's col. 8, lines 5-10.

Regarding **claim 62**, it is noted that all the elements recited in claim 39, including the second storing unit the second selecting unit, the second transmitting unit are noted to be components included in the consumer electronic device or the television set of Darbee, which communicates information from and to the remote controller 10, for these components are conventional elements included in a television system.

As per **claim 64**, the claimed "second electric apparatus is a personal computer, ... accesses a server based on information transmitted from the control device" would have been obvious over Darbee's col. 4, lines 50-56, since the system can access the Internet via a modem (see col. 4, lines 30-33).

In **claims 65 and 67**, the claimed "notifying unit for notifying a user of reception... transmitted in response to an instruction that was issued from the control device" is met by item 14 of fig. 1.

As per **claims 68-69**, the claimed "output means outputs that part of the additional information which relates to a current channel reception of the electric apparatus ... from a present time onward" would have obvious the system of Darbee, since it enables the user to view program guide, identifying PPV information (see fig. 12) select information pertaining to specific genres or categories (see fig. 32) and to

retrieve the selected category (*see col. 6, lines 38-41*) transmitted from the television set. See for example fig. 7, and col. 2, lines 2, lines 6-67, col. 3, line 31 to col. 4, line 5, and col. 9, lines 58-65.

The invention of **claims 70-71, 74-84, 87-96, and 99-108**, although slightly different, they recite the underlying features of claims 56-69, respectively. As the various features of claims 56-58, and 60-69 have been shown to be obvious in view of the combined teachings of Darbee, Jones and Kishtaka, it is readily apparent that the apparatus disclosed by the prior art perform the recited underlying functions. As such, the limitations recited in **claims 70-71, 74-84, 87-96, and 99-108** are rejected for the same reasons and rationale given above for claims 56-69, and incorporated herein.

4. **Claims 40, 52, and 63** are rejected under 35 U.S.C. 103(a) as being unpatentable over Darbee in view of Jones and further in view of Takahashi and further in view of Hirose.

Considering **claims 40, 52**, Darbee, Jones, and Takahashi render obvious most claimed features of the invention but they fail to suggest that the second electronic apparatus is a recording apparatus performing recording reservation or a computer accesses a server based on the information transmitted from the control device.

Nonetheless, Hirose at fig. 1 illustrates a recording medium 7 as one of a plurality of electronic devices receiving information transmitted from a broadcasting station. Such recording medium is shown interfacing with a receiver. Such receiver is noted to be capable of receiving cable television broadcasting which could be used with a remote controller for transmitting signal to the receiver. Hirose also shows that a personal computer may be used to receive the information via a local area network. It is

to be appreciated that computer, by means of the LAN, is able to access a server as is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings suggested by Darbee and Takahashi and to incorporate their features with Hirose, in order to enhance the flexibility of the system.

Claim 63 recites the features of claim 40 it is similarly rejected.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 33-34, 37-57, 60-71, 74-84, 87-96, and 99-108 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of co-pending application with serial number 09/706,945, hereinafter the '45 application. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '45 application is somewhat a broader recitation of the present claimed invention. For instance, in claims 33, and 47 of the present application, claims 1 and 8 of the '45 application, recite:

The control device; the electric apparatus; the transmission medium with transmitting means; the receiving means; and the extractions means; the additional information outputting means and the display device means, all performing the same functions as their equivalents in the '45 application.

The '45 application, 1 and 8 for example, fails to show how the additional information are created, stored, and transmitted from the electric apparatus and that it is advertisement information, like coupon information.

The '45 application shows a broader aspect on how the additional information are controlled and transmitted to the receiving means for display, but missing steps of claims 1 and 8 of the '45 application are recited in the claims of which claims 1, and 8 depend. See for example claims 4, and 9.

Thus, it would have been obvious to an artisan skilled in the art at the time the invention was made to have used the teaching of claims 1-32 of the '45 application as a general teaching for a control device that controls and transmits additional information that has been extracted from an electric apparatus to a receiving means for display; in order to derive at a control device which controls an electric apparatus transmitting additional information extracted by an extracting unit to a receiver, to receive information transmitted via a transmission medium. The '45 application and claims

obviously encompass the claimed invention of the instant application and differ only in terminology and broader steps. The extent that the '45 application's claims are broaden and therefore generic to instant claimed invention [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

6. Claims 33-34, 37-57, 60-71, 74-84, 87-96, and 99-108 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33-82 of co-pending application with serial number 09/707,007, hereinafter the '07 application. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application is somewhat a broader recitation of the '07 application's claimed invention. For instance, in claims 33, and/or 47 of the present application, like claims 33 and/or 50 of the '07 application, recites:

The control device; the electric apparatus; the transmission medium with transmitting unit; the receiving unit; and the extracting unit; and the additional information outputting unit, all performing the same functions as their equivalents in the '07 application. The '07 application, claim 33, only limits itself from the instant application by reciting that the additional information advertisement information, like coupon information.

However, the '07 application, recite the missing steps in the dependent claims of which claim 33 or claim 50 depend. See for example, claims 34-49.

Thus, it would have been obvious to an artisan skilled in the art at the time the invention was made to have used the teaching of claims 33-108 of the '45 application as a general teaching for a control device that controls and transmits additional information

that has been extracted from an electric apparatus to a receiving means for display; in order to derive at a control device which controls an electric apparatus transmitting additional information extracted by an extracting unit to a receiver to receive information transmitted via a transmission medium. The '07 application and claims obviously encompass the claimed invention of the instant application and differ only in terminology and broader steps. The extent that the '07 application's claims are broaden and therefore generic to instant claimed invention [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

Conclusion

7. The prior art considered pertinent to the Applicants' disclosure are as recited in the PTO-892 form.

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Art Unit: 2676

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesner Sajous whose telephone number is (703) 308-5857. The examiner can also be reached on Mondays thru Thursdays and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella, can be reached at (703) 308-6829. The fax phone number for this group is (703) 308-6606.

WS

3/29/03

